No. 80-1077

In the Supreme Court of the United States

OCTOBER TERM, 1980

NEAL FACTOR AND NAT ZIMMERMAN, PETITIONERS

v.

COMMISSIONER OF PATENTS AND TRADEMARKS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

Whether there is substantial support in the record for the Court of Customs and Patent Appeals' finding that petitioners' device is "obvious" under 35 U.S.C. 103 and is thus not patentable.

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OPINIONS BELOW

The opinion of the Court of Customs and Patent Appeals (Pet. App. 7a-9a) is unreported. The opinion of the Board of Appeals (Pet. App. 1a-6a) also is unreported.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on October 2, 1980. The petition for a writ of certiorari was filed on December 31, 1980. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

STATUTE INVOLVED

35 U.S.C. 103 provides in relevant part:

> A patent may not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

STATEMENT

1. On July 23, 1976, petitioners Neal Factor and Nat Zimmerman filed a patent application entitled "A System for the Synchronous Projection of Motion Pictures and Laser Light Patterns" (App. R. 2).[1] The application described a device that projects laser light directly onto a screen on which a conventional motion picture is being projected. According to the application, this system can produce complementary images of a brillance, intensity, and appearance

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[1]The abbreviation "App. R." refers to the record filed by petitioners in the Court of Customs and Patent Appeals.

not obtainable by conventional motion picture projection (*ibid.*).[2] Petitioners readily admitted that they were not the first to complement film images with enhancing light; rather, they claimed that they were the first to devise the particular system of cooperating elements described above (*id.* at 2-4).

2. On July 28, 1978, the hearing examiner rejected petitioners' claims 24-37, the subject of the instant petition, as being unpatentable by reason of obviousness under 35 U.S.C. 103, in view of three prior art references—McCormick, Akin, and Bau.[3] The examiner found that, as early as 1918, the McCormick patent disclosed the practice of producing lighting effects on a screen in synchronization with motion picture film (App. R. 55). The examiner recognized that lasers were not known in 1918, but he observed that, using the kind of lighting then available, McCormick placed contacts on the film at proper locations to synchronize the lights with the film and produce desired visual effects (*ibid.*). The examiner also noted the acknowledgment in petitioners' application that use of lasers to provide visual

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[2]Petitioners' patent application cites the following example of the kind of effect that petitioners' system could produce (App. R. 6):

> a scene in which a spaceship, firing a ray-gun, is approaching a planet surrounded by multi-hued Saturn-like rings. The image of the spaceship and the planet would be photographed and projected by conventional motion picture equipment. The Saturn-like rings and the "ray" from the ray-gun would be projected by a multi-color beam, multiple scanning assembly system. At the instance [*sic*] that the appropriate frames of the scene are projected by the film, the accompanying synchronized audio tape would contain the corresponding information to drive the scanning assemblies.

[3]Petitioners' patent application had 21 claims when it was first filed. An amendment added claims 22 and 23. Claims 1-23 are not in issue here. A subsequent amendment added claims 24-37. Claim 24, petitioners' principal claim, appears at App. R. 44-45.

effects for motion pictures was not new (App. R. 3), and he cited patents issued to Akin in 1965 and Bau in 1973 as evidence of this practice (App. R. 54).

3. The Board of Appeals affirmed (Pet. App. 1a-6a). Like the hearing examiner, the Board of Appeals relied in part on petitioners' acknowledgment that "they were not the first to complement film images with enhancing light" (Pet. App. 2a). The Board also noted that "[n]othing in claim 24 requires that the laser display be projected on the screen itself" (*id.* at 3a). Looking at the prior art, the Board found that (1) the McCormick patent suggests the automatic projection of light on the screen and (2) the Akin and Bau patents confirm that, at the time petitioners designed their system, hardware was available to construct a means to control the laser beam automatically so as to produce coherent light patterns (*id.* at 4a). Moreover, the Board found that the desirable properties of laser light were known to workers in the art (*id.* at 5a). Inasmuch as the effect of using lasers to make light patterns was readily predictable, the claimed innovation was deemed obvious.[4]

4. The Court of Customs and Patent Appeals affirmed (Pet. App. 7a-9a). The CCPA agreed with the rationale of the two prior decisions, stating that "[t]o apply modern-day, concedely [*sic*] known laser apparatus to McCormick would have been obvious to one skilled in the art of optical display systems, thus rendering the claimed subject matter obvious under 35 USC 103" (Pet. App. 8a-9a).

ARGUMENT

The Court of Customs and Patent Appeals correctly concluded that the system that petitioners seek to patent is

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[4]Noting that petitioners did not advance any argument that would distinguish their dependent claims from their main claim, the Board held that all claims stood or fell together (Pet. App. 5a). Petitioners do not contest this conclusion.

obvious in view of the prior art. Contrary to petitioners' contentions, this decision raises no significant legal question, and further review by this Court is unwarranted.

The Patent Act establishes three general requirements for patentability—novelty and utility (35 U.S.C. 101 and 102) and nonobviousness (35 U.S.C. 103). This case turns on the nonobviousness requirement. In *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966), this Court outlined the analysis to be used when obviousness is at issue:

> the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.

The CCPA applied this standard, and its decision finds substantial support in the record.

1. Petitioners concede that use of lasers to provide visual effects for motion pictures and theatrical lighting is familiar. They also concede that they are not the first to complement film images with enhancing light and that their mechanism uses already existing components. See Pet. App. 8a. The CCPA compared the prior art with petitioners' device and correctly concluded that the device is an obvious refinement of systems devised by prior inventors. The McCormick patent describes a motion picture apparatus that uses auxiliary lights automatically and electrically projected on the screen to cooperate with the film presentation (App. R. 70). McCormick's system is similar in construction and operation to petitioners' device in many respects (App. R. 55). The Akin patent covers an optical display system, including scanning means and shutter controls (App. R. 79). The Akin patent clearly suggests that a coherent light beam (a laser) can be controlled in a visual display in the same way as petitioners' laser beams are controlled. The Bau patent discloses a laser display system useful for

theaters (App. R. 82). In his summary of the invention, Bau states that his laser light may be projected from in front, behind, or below the screen, or from various other positions to obtain the desired effect (App. R. 84). Thus, the positioning of Bau's display is the same as the several alternative positions disclosed in petitoners' application (App. R. 27-30).

2. The CCPA correctly concluded that petitioners' invention would have been obvious to one possessing "the level of ordinary skill in the pertinent art." *Graham* v. *John Deere Co., supra*, 383 U.S. at 17. Obviousness is measured "not by considering what was obvious to actual artisans but by considering whether a hypothetical person, having all of the prior art at hand, would have found the same solution when addressing himself to the same problem." *Republic Industries, Inc.* v. *Schlage Lock Co.*, 592 F. 2d 963, 975 (7th Cir. 1979). As the CCPA observed in *In re Rosselet*, 347 F. 2d 847, 851 (1965), "the test of obviousness is * * * what the references taken collectively would suggest to those * * * familiar with them." The only colorably innovative feature of petitioners' system is the storage device that automatically controls the laser display. However, as the Board of Appeals noted, "it is obvious to do automatically things that were [formerly] done manually" (Pet. App. 4a). Hence, the evidence, viewed collectively, supports the decision below that petitioners' design is no more than an obvious advance over the prior art (*id.* at 8a).[5] See *Hotchkiss* v. *Greenwood*, 52 U.S. (11 How.) 248, 267 (1850).

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[5]There is no merit to petitioners' contention (Pet. 22) that the patent examiner's survey of the pertinent art, accepted by the Board of Appeals and the CCPA, is overly broad. The prior art that is pertinent in evaluating a claim of obviousness "is defined by the nature of the problem confronting the would-be inventor." *Republic Industries, Inc.* v. *Schlage Lock Co., supra*, 592 F. 2d at 975. Accordingly, in this

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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case optical display devices, not the motion picture devices suggested by petitioners, constitute the pertinent art. In any event, two of the three references cited by the examiner, the Board of Appeals, and the CCPA involve motion picture effects.